

## **REMARKS**

This is an amendment after final action filed in response to the **final** Office Action mailed on April 26, 2011. The only claim changes that are proposed are claim changes to overcome the rejection for failing to comply with the written description requirement under 35 U.S.C. § 112, first paragraph. Thus these claim changes should be entered under 37 C.F.R. § 1.116, because they put the claims in a better form for appeal if necessary (see 37 C.F.R. § 1.116 (b) (1) & (2)). Furthermore since the pending claims are free of the prior art, they put the claims in a condition for allowance.

### **I. Rejections Based on Prior Art**

The final Office Action has expressly withdrawn all previous rejections based on the disclosures in the prior art. Accordingly the amended claims are considered to be free of the prior art.

## **II. Rejection for Failing to Comply with the Written Description Requirement**

Claims 33 to 36, 38, and 41 to 51 were rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement.

Some of the amount ranges for the auxiliary ingredients in the originally filed claim 42 indeed were not adequately supported by the written description on page 7 of the applicants' originally filed specification. It is respectfully submitted that the above changes have corrected that situation.

Page 7, 3<sup>rd</sup> **full** paragraph, of the specification states that the amount range of 0.01 to 5 wt. % applies to **each** of the opacifiers, perfume oils, dyes and preservatives in the auxiliary ingredients. Claim 42 has been amended accordingly by insertion of the word "each" in the paragraph reciting the amounts of these auxiliary ingredients.

Page 7, second **full** paragraph, of the specification discloses that the auxiliary agents can include hair-care agents. It also

discloses examples of hair-care agents. Page 7, third full paragraph, states that hair-care constituents may be included in the auxiliary agents and that they can be contained in the composition in an amount of 0.1 to 5 wt. % each.

The term "hair-care agent" would be considered by one skilled in the art to be synonymous with the term "hair-care constituents". Both would be considered to mean an ingredient or chemical compound with hair-care properties.

The examples of the hair-care constituents given in the second full paragraph on page 7 include cationic resins, lanolin derivatives and cholesterol. However these are categories of hair-care constituents, except in the case of cholesterol. Thus because of the term "each" in line 7 of the third full paragraph on page 7 of applicants' specification, each of the hair-care ingredients (constituents) in the category of cationic resins or lanolin derivatives that is present in the composition may be present in the composition in an amount of 0.1 to 5 wt. %.

However the term "derivatives" in composition claims often leads to their rejection as indefinite. Hence the term "lanolin derivatives" has been replaced by "lanolin, lanolin alcohols, lanolin

alkoxylates". Examples 32 and 34 provide the basis for limiting the term "lanolin derivatives" to "lanolin, lanolin alcohols, and alkoxylates". In addition, note that the term "wool grease", which is an ingredient of examples 48 to 49 is an alternative term for "lanolin" according to Wikipedia Encyclopedia on the Internet.

A generic description of an ingredient in a composition claim may be limited to a specific ingredient or ingredients that fall within the generic description, as long as the specification discloses the specific ingredients at some point. Thus it should be acceptable to replace "lanolin derivatives" by specific examples disclosed in the applicants' specification. Also because of the term "each" one skilled in the art would understand that each hair-care ingredient can be present in an amount of 0.1 to 5 wt. %.

According M.P.E.P. 2163.05 II the criteria for adequate support of claim changes that narrow a generic composition claim is whether or not the specification discloses the species or not. The applicants' specification teaches that the auxiliary ingredients may include lanolin derivatives. The generic claim 42 recites specific lanolin derivatives among the other auxiliary ingredients, which are disclosed in the specification, e.g. lanolin alcohol, but these specifically recited lanolin derivatives are disclosed in the examples

at the end of applicants' specification. One skilled in the art does not need an explicit statement in specification that lanolin alcohol is a lanolin derivative, because that is common knowledge in the cosmetic arts. Thus the recitation of lanolin alcohols and lanolin alkoxyates in claim 42 should not be considered to violate the written description requirement.

Claims 48 to 50 have been amended to overcome their rejection under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. The changes suggested on page 3 of the final Office Action have been made to overcome this formal rejection, except that the preamble of claim 49 has also been amended to provide a more logical title for the claimed method based on the disclosures of example 3 on page 12 of the applicants' originally filed specification.

For the aforesaid reasons and because of the changes in claims 42, 48, 49, and 50, withdrawal of the rejection of claims 33 to 36, 38, and 41 to 51 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement is respectfully requested.

### **III. Withdrawn Claims**

Withdrawn claim 19 has been amended to make the same changes in the recitation of the auxiliary agent that were made in claim 42.

The primary distinguishing features in method claim 42 reside in the composition with the active ingredient recited in step a. Main agent claim 19 is a composition claim with the same limitations as in step a of claim 42. Hence claim 19 contains the same distinguishing limitations as claim 42 and should also be considered to be free of the prior art.

For the aforesaid reasons agent claims 19 and 23 to 29 should be rejoined and allowed under the doctrine of rejoinder M.P.E.P. § 821.04, since the above-identified U.S. patent application is the national stage of PCT/EP 2005/001442. Since this is a U.S. National stage application of a corresponding PCT International Application, unity-of-invention practice applies. Both amended claims 19 and 42 contain the same common technical factors that distinguish their subject matter from the prior art of record. Thus in accordance with PCT Rule 13.1 and 13.2 claims 19 and 23 to 29 should be rejoined and allowed.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects to put this case in condition for final allowance then it is requested that such amendments or corrections be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing the case to allowance, he or she is invited to telephone the undersigned at 1-631-549 4700.

In view of the foregoing, favorable allowance is respectfully solicited.

Respectfully submitted,



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